

Remarks

Claims 12 - 20 have been rejected under 35 U.S.C. § 102(b) over Hauptman WO/01/923342 (hereinafter "*Hauptman*"). As discussed in previous responses, and uncontested by the Examiner, *Hauptman* discloses a myriad of complexes, but in those most closely to the present invention, requires branching at both carbons attached to the two imino groups (the "imino carbon"), while Applicant's claims expressly preclude such branching in at least one of these groups.

However, the Examiner has maintained the rejection, apparently on the grounds that when an aryl hydrocarbon group is attached to the imino nitrogen, the fact that the carbon atom bound to the imino nitrogen is part of an aryl ring somehow precludes this carbon atom from being "branched". However, the Examiner has offered no support for this proposition, which is totally conclusory, and at odds with both the ordinary meaning of "branched" as well as the definition which would be ascribed by one of ordinary skill in the art.

WEBSTERS NEW COLLEGIATE DICTIONARY defines "branch" as "to spring out from" or "diverge." With reference to the illustrations in Applicant's last response, it can be clearly seen that the imino carbon in any aryl group attached directly to the imino nitrogen is a branch point, and that a directly bonded aryl group, as opposed, for example to a benzyl group, is clearly branched, since two divergent paths may be taken from the point of attachment "branch point". Such directly bonded aryl groups are thus clearly branched.

In view of Applicant's submission, the burden shifted to the Office to go forward with evidence which would support any contrary meaning. *In re Piasecki*, 223 U.S.P.Q. 785 (Fed. Cir. 1984). Rather than submit any such evidence to satisfy this burden, the Examiner has merely alleged, without support, that one skilled in the art would view branching in a different way. Conclusory opinions are not evidence, and cannot be used to reject a claim. *In re Soli*, 137 U.S.P.Q. 797 (CCPA 1963).

Accompanying this response is the Declaration of Dr. James W. Proscia, who has a Ph.D. in chemistry from Harvard University, who has been an adjunct professor of organic chemistry at Wayne State University and who assisted with the preparation of the present application. As can be seen from his Declaration, an aryl group attached directly to an imino nitrogen is indeed a “branched hydrocarbon.” Note that the claims do not recite “branched aliphatic hydrocarbon” nor “branched alkyl”, but “branched hydrocarbon.”

Moreover, as the Federal Circuit has repeatedly held, the test for anticipation is “strict identity,” and thus cases involving anticipation are “quite rare.” *Trintec v. Top U.S.A.*, 63 U.S.P.Q. 2d 1597 (Fed. Cir. 2002). The rejection under 35 U.S.C. § 102(b) must be withdrawn for this reason.

Finally, *Hauptman* is not prior art, as the Applicant conceived of the invention and reduced it to practice prior to *Hauptman's* effective date of December 6, 2001. A Declaration attesting to the earlier conception and reduction to practice can be submitted if the Office desires. However, since the present rejection is not tenable, Applicant's attorney sees no need to impose the time and expense of the preparation of such a Declaration on the Assignee.

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, he is highly encouraged to telephone Applicants' attorney at the number given below.

Respectfully submitted,

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By 

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 1713

LINDA N. WINSLOW

Examiner: Robert D. Harlan

Serial No.: 10/087,028

Filed: March 1, 2002

For: DIMINE COMPLEXES FOR OLEFIN POLYMERIZATION

Attorney Docket No.: LYON 0127 PUS

DECLARATION UNDER 37 C.F.R. § 1.132

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, James W. Proscia, do hereby declare and state as follows:

1. I obtained a B.S. in Chemistry, *magna cum laude* from New York University, an M.A. in physics from Harvard University, and a Ph.D. in Chemical Physics from Harvard University, where my principle field of study was in vapor deposition from organometallic precursors. I have also been an Adjunct Professor of Chemistry at Wayne State University, and am the named inventor on 15 patents in the area of vapor deposition and coatings, in particular chemical vapor deposition employing organometallic coating precursors.

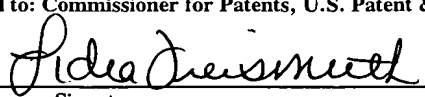
2. I am familiar with the present application, U.S. Serial No. 10/087,028, and the Office Actions of record.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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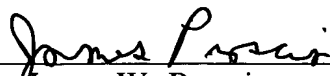
3. The claims of the application require at least one of the substituents not to be branched at the imino carbon atom, and I understand the Examiner's position to be that an aryl group directly bonded to the imino nitrogen of the claimed complexes is not branched.

4. As one skilled in the field of Organic Chemistry, the Examiner's conclusion is wrong.

5. A branch in a hydrocarbon is an assembly of linkages which allows divergent paths to be taken from a branch point, in this case, from the carbon atom bonded directly to the imino nitrogen. In an aryl group directly bonded to an imino nitrogen, the carbon atom thus bonded is clearly a branch point as that term is understood in Organic Chemistry, and an aryl group thus attached is clearly branched.

It is noted that the claim language pertains to branched hydrocarbons, not to branched aliphatic hydrocarbons nor to branched alkyl groups. An aryl group bonded directly to an imino nitrogen is clearly understood by one of ordinary skill in the art of organic chemistry as "branched at the imino carbon."

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.



Dr. James W. Proscia

Dated: 9/16/04